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MAR 31 2006

OFFICE OF PETITIONS

In re Application of Leonard Sadjadi
Application No. 09/736,354
Filed: December 14, 2000
Attorney Docket No. LSUI-27,721US

Decision Granting
Petition

This is a decision on the petition filed March 9, 2006, by attorney James Bradley. The petition will be treated as a petition under 37 CFR 1.183.

The petition is **GRANTED**.

Summary of March 20, 2006 telephone conversation and March 23, 2006 voicemail:

The March 9, 2006 petition requests:

- (1) the Commissioner personally reconsider the prior decisions rendered in response to several petitions filed in the instant application;
- (2) reconsideration of the petition to withdraw from issue; and
- (3) the addition of Micrin's name to the front of the patent.

The undersigned and James Bradley discussed the petition on March 20, 2006, during a telephone conversation. Subsequently, Bradley contacted his clients to discuss issues raised during the telephone conversation.

On March 23, 2006, Bradley left a voice-mail indicating petitioner no longer wished to pursue the relief requested in items (1) and (2) listed above.

Facts:

Leonard Sadjadi is the sole inventor. Sadjadi is the Director of L.S. Unico, Inc. (Unico). On December 13, 2000, the inventor assigned 50% of his rights to Unico and 50% of his rights to Micrin Technologies Corporation (Micrin).

On December 13, 2000, Sadjadi signed a declaration giving power of attorney to James Bradley, Frank Vaden, Charles Gunter, and Andrew Dillon.

The application and the executed declaration were filed on December 14, 2000.

A non-final Office action was mailed April 14, 2003. The Office action set a shortened statutory time period for reply of three (3) months. The time for reply was extendable by up to 3 months with the proper payment of an extension of time fee. The maximum extendable period for reply ended on October 14, 2003.

After review of the Office action, Micrin made a decision not to file a reply. Micrin sent a letter to Unico on September 22, 2003, informing them of Micrin's intention. The letter stated,

We are hereby giving L.S. Unico our formal notice not to further pursue this patent application.... [T]he costs associated with pursuing [prosecution] are not in Micrin's financial best interests....

Micrin will cover all legal expenses up to the date of this letter. If you desire to [continue prosecution], Micrin is prepared to execute a contract that assigns all rights to the patent application to L.S. Unico.

The final extension of time to respond to the USPTO's rejection runs through October 14, 2003.... Micrin's IP attorney, James E. Bradley had indicated that, if you act expeditiously, there is time for a lawyer to draft [a reply] and submit it before the deadline.

We wish you the best of luck with whatever decision you make regarding the patent.

Unico's law firm of Chauza & Handley responded to Micrin's letter on September 25, 2003. The response included a proposed assignment agreement.

On behalf of Micrin, attorney Roger Albright mailed a response on October 2, 2003. The letter stated,

Micrin has already indicated ... it will not [be further prosecuting the application]. Micrin has no objection to L.S. Unico pursuing an appeal of the USPTO's rejection and ... is willing to consider assigning its interests to L.S. Unico. The terms under which Micrin would be prepared to make such an assignment are as follows:...

[Unico's proposed assignment] would require that Micrin accept various responsibilities regarding [the application]. Micrin does not wish to have any further involvement in that product or patent process....

Please contact me after you ... review this proposal with your clients. If they are interested in moving forward, I will draft the appropriate documents for your review. If not, I advise once again on behalf of Micrin that it will not be moving forward [with prosecution of the application].

Unico did not allow the application to go abandoned. Instead, Unico mailed a reply to the Office action on October 14, 2003. The reply was accompanied by payment of \$475 for a three month extension of time. On the same day, Unico filed a "Revocation and Appointment of Power of Attorney and Statement Under 37 C.F.R. § 3.73(b)." The revocation and power of attorney was signed by Sadjadi - the sole inventor and the Director of Unico. The revocation and power of attorney was accepted and entered by the Office. As a result, the representatives of record became Roger Chauza and Mark Handley. The address of record was changed to the address associated with the new law firm's customer number.

Micrin alleges it was unaware that Unico had chosen to pursue prosecution of the application.

An Office action was mailed on January 28, 2004.
Unico filed a reply on March 3, 2004.

An Office action was mailed on May 17, 2004.
Unico filed a reply on June 17, 2004.

During June of 2004, Unico and Micrin disagreed with respect to several business matters. Legal counsel for both parties communicated during the next few months.

A final Office action was mailed on November 2, 2004.
Unico filed a reply on January 3, 2005.

A Notice of Allowance and a Notice of Allowability were mailed on February 22, 2005.

Unico, via attorney Gary Patton, filed a complaint in the County Court At Law of Dallas County, Texas, on March 16, 2005. The complaint seeks to have the assignment to Micrin nullified. A nullification of the assignment to Micrin would result in Unico being the sole owner of the patent.

Micrin's answer was filed June 15, 2005.

Unico timely paid the issue fee on May 9, 2005.

The application was scheduled to issue as Patent no. 6,919,810, on July 19, 2005.

On July 12, 2005, Micrin's attorney, James Bradley, filed a petition to withdraw the application from issuance until ownership issues could be resolved.

The petition to withdraw from issue alleged the prior revocation and power of attorney had only been signed by one assignee and was therefore improper. Although the petition was dismissed on July 14, 2005, the Office failed to note the revocation and power of attorney had been signed by the sole inventor. As a result, the Office improperly vacated the past revocation and power of attorney.

A renewed petition to withdraw from issue was filed on July 18, 2005. The petition included a statement expressly abandoning the application in favor of a continuing application. MPEP 1308 required petitioner to identify "some specific and significant defect in the allowed application before the application will be withdrawn from issue." Petitioner stated the defect was the cancellation of claims during prosecution without petitioner's consent which "may irreparably harm petitioner."¹

A decision granting the petition was mailed July 18, 2005. The express abandonment resulted in the application becoming abandoned on July 18, 2005, one day before the application would have issued as a patent.

The continuation application was assigned application no. 11/183,431. A copy of the declaration filed in the instant application was filed in the continuation application. As a result, Bradley and the other attorneys who were listed in the declaration are the current attorneys of record in the continuation application. The Office notes petitions have been filed by both assignees in the continuation application. However, decisions have not yet been rendered in response to the petitions.

On August 10, 2005, Unico filed petitions which, in essence, sought for the Office to vacate the decision granting the petition to withdraw from issue and sought for the Office to issue the application as a patent.

Micrin filed a response to Unico's petition on August 19, 2005.

A decision favorable to Unico was mailed on November 18, 2005. The decision vacated the decision granting the petition to withdraw from issue. The decision instructed the Office of Publications to take steps to issue the application as a patent.

Micrin filed a petition on November 23, 2005. The petition requested reconsideration of the November 18, 2005 decision, and for the Office to withdraw the application from issue. In the

¹ Page 3 of the July 18, 2005 petition.

alternative, the petition requested the Office delay issuance of the patent and allow Micrin to take steps to have its name added to the face of the patent.

The Office reconsidered the November 18, 2005 decision, and determined the decision was correct. The Office determined that Micrin's name would not appear on the face of the patent, *but* that Micrin could file a petition under 37 CFR 3.81(b).

Analysis:

Micrin requests its name be added to the face of the patent.

The Office has been supplied with an assignment signed by the sole inventor which assigns 50% of his ownership interest to Micrin. The fact that a court *may* eventually grant Unico equitable relief and allow rescission of the contract does not change the fact that Micrin is currently an assignee.

Effective June 25, 2004, the practice relating to issuance of a patent to an assignee was modified by requiring that, after payment of an issue fee, a request for a certificate of correction must be filed in order to obtain issuance of the patent to an assignee. Thus, where the assignment data is submitted after payment of the issue fee, the patent document will not include the assignment information.

37 CFR 3.81(b), as modified, reads:

Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a)) and the processing fee set forth in § 1.17(i) of this chapter.

For Micrin's name to appear on the face of the patent, the Office must waive 37 CFR 3.81(b).

Rule 183 allows for a party to seek waiver of rules in extraordinary situations where justice requires waiver of one or more rules. Waiver of a rule is an equitable remedy.

The Office has determined that equity requires the addition of Unico's name to the face of the patent if Micrin's name is added to the face of the patent. In other words, the Office will *sua sponte* waive 3.81(b) to add Unico's name to the face of the patent upon any determination that Micrin's name will be added to the face of the patent.

Should steps be taken by the Office to ensure the names of the two assignees are added to the face of the patent?

Micrin alleges issuance of the patent without Micrin's name might eventually result in harm to Micrin. The sincerity of Micrin's belief is shown by the large amount of time and effort Micrin has spent in attempts to have the patent issue with Micrin's name. The Office recognizes Micrin's concerns are not frivolous or insignificant.

Upon consideration of all the facts and circumstances, the Office has determined that equity warrants waiver of 37 CFR 3.81(b). The Office will take steps to ensure the names of both assignees appear on the face of the patent.

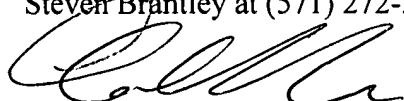
The fee for a petition under 37 CFR 1.183 is \$400. Therefore, the Office will charge \$400 to Bradley's deposit account.

The Office of Publications will be informed of the instant decision and will take steps to issue the application as a patent bearing the names of both the assignees:

L.S. Unico, Inc.
Dallas, Texas

Micrin Technologies Corporation
Dallas, Texas

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



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